

REMARKS

I. Introduction

Claims 1-28, 30-53, 59-64, and 81-87 are currently pending in the present application. Claims 1, 30, 47, 49, 51-53, 59, 63-64, 81, and 85-86 are independent. All claims stand rejected. In particular,

(A) claims 1-28 stand rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite;

(B) claims 1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53, and 59-64 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent Publication No. 2002/0049631 (hereinafter “Williams”);

(C) claims 81-87 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 6,017,063 (hereinafter “Nilssen”);

(D) claims 5, 10, 34, and 39 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 5,970,470 (hereinafter “Walker”); and

(E) claims 26-27, and 45 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of U.S. Patent No. 4,723,212 (hereinafter “Mindrum”).

Upon entry of this amendment, which is respectfully requested, claim 13 will be cancelled without prejudice or disclaimer and claims 1, 30, 47, 49, 51-53, 59, 63-64, 81, and 85-86 will be amended. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Interview Summary

Initially, Applicants thank Supervisory Patent Examiner John Hayes for taking the time to review the inconsistencies associated with the use of the Williams reference throughout prosecution of the present application. Based on the insights provided by Supervisory Patent Examiner John Hayes, Applicants now have a much clearer

understanding of the current grounds for rejection with respect to the Williams reference, and Applicants believe that this paper should most appropriately place all pending claims in condition for allowance or in stronger form for appeal.

III. The Examiner's Rejections

A. 35 U.S.C. §112, second paragraph

Claims 1-28 stand rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite. While Applicants do not necessarily agree that the “charging” step of claim 1 is incompatible with the limitations of claim 13, Applicants nonetheless cancel claim 13 herein, solely to advance prosecution. The cancellation of claim 13 herein renders this ground for rejection moot.

Accordingly, Applicants hereby respectfully request that the §112, second paragraph rejections of claims 1-28 be withdrawn.

B. 35 U.S.C. §102(e) – Williams

Claims 1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53, and 59-64 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by Williams. Applicants traverse this ground for rejection as follows.

1. Claims 1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53

Applicants respectfully submit that Williams fails to teach or suggest limitations of claims 1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53. Williams fails to teach or suggest, for example, *determining a price for said benefit, wherein said price is a non-zero monetary amount*.

Applicants note that Williams describes providing coupons *freely* to customers (*i.e.*, Williams does not charge customers for the coupons it gives out). While Applicants believe the above-listed claims distinguished over Williams prior to the current amendment (*e.g.*, because Williams does not determine *any* price for the benefit), Applicants nonetheless provide amendments herein intended solely to advance

prosecution by reciting specifically that the price is a **non-zero monetary amount** (which Williams *clearly* does not teach).

Accordingly, as Williams fails to teach or suggest limitations of claims **1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53**, Applicants respectfully request that the §102(e) rejections of claims **1-4, 6-9, 11-25, 28, 30-33, 35-38, 40-44, 46-53** be withdrawn.

2. Claims 59-64

Applicants respectfully submit that Williams fails to teach or suggest limitations of claims **59-64**. Williams fails to teach or suggest, for example, *wherein said benefit allows said customer to purchase said at least one product during a **second transaction at said first price*** (a limitation generally recited by each of claims **59-64**).

The Examiner cites paragraphs [0020] and [0038] of Williams to show how Williams teaches the above-quoted limitation. Applicants have reviewed these paragraphs of Williams (as well as the remainder of Williams) and can find no mention of any subject matter related to allowing the customer to purchase the product for the first price in the second transaction. Applicants note, in general, that Williams provides coupons that give a customer a discount (such as a percentage off of a purchase price). As purchase prices themselves often change, a “percentage off” the purchase price **does not allow** the customer to purchase the product at *the first price* in the second transaction¹.

Accordingly, as Williams fails to teach or suggest limitations of claims **59-64**, Applicants respectfully request that the §102(e) rejections of claims **59-64** be withdrawn.

C. 35 U.S.C. §103(a) – Williams, Nilssen

Claims **81-87** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Nilssen. Applicants traverse this ground of rejection as follows.

¹ The Examiner’s attention is directed to the two previous Responses and the two previous Appeal Briefs submitted in this case (the arguments of which are incorporated herein by reference), which provide detailed discussions of how Williams fails to teach such an embodiment.

1. Claims 81-84

Applicant respectfully submits that neither Williams nor Nilssen, alone or in combination, teaches or suggests limitations of claims **81-84**. Williams and Nilssen fail to teach or suggest, for example, *in which the benefit comprises a guarantee that **no more than the first price** for a second unit of the product **will be charged** if the second unit of the product is purchased **as part of a second transaction**.*

The Examiner states that Williams fails to teach or suggest the above-quoted limitation. Office Action mailed November 4, 2005, pg. 7, third paragraph from bottom. The Examiner then relies upon Nilssen to make up for the deficiencies of Williams.

The Examiner, however, is simply misinterpreting the Nilssen reference. Nilssen describes a customer paying a purchase price for a product (as part of a first transaction) to receive a certificate. The certificate may then be redeemed for the product in a later transaction, without paying any money, as the customer has already paid for the product. This is akin to a “lay away” program.

Nowhere does Nilssen describe guaranteeing *a future purchase* of a *second unit* of the product **to be no more than a price already paid for a first unit** of the product. Indeed, because the customer in Nilssen has already paid the purchase price for the product (in exchange for the certificate), no future purchase even occurs in Nilssen. Accordingly, Nilssen simply fails to make up for the deficiencies of Williams.

Further yet, even if the references taught or suggested all claimed limitations (which Applicants submit they do not), the Examiner has not pointed to any specific motivation that would have led one skilled in the art to make any of the alleged combinations, nor has any evidence been submitted in support of such allegations. The Examiner simply makes a conclusory statement that combining the references would be ‘good’, and cites a portion of Nilssen that has nothing to do with motivating one to combine the references. This falls far short of meeting the Examiner’s burden of establishing a *prima facie* case for obviousness.

At least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claims **81-84**. Accordingly, Applicants respectfully request that the §103(a) rejections of claims **81-84** be withdrawn.

2. Claim 85

Applicant respectfully submits that neither Williams nor Nilssen, alone or in combination, teaches or suggests limitations of claim 85. Williams and Nilssen fail to teach or suggest, for example, *in which the benefit comprises a guarantee that **an amount that is not greater than the purchase total will be charged for the plurality of products during a second transaction.***

The Examiner states that Williams fails to teach or suggest the above-quoted limitation. Office Action mailed November 4, 2005, pg. 8, third paragraph from bottom. The Examiner then relies upon Nilssen to make up for the deficiencies of Williams.

As described in Section C.1. above, however, the Examiner is simply misinterpreting the Nilssen reference. Nowhere does Nilssen describe a second transaction, or a purchase of multiple products, much less guaranteeing *a future purchase price of the plurality of products*. Accordingly, Nilssen simply fails to make up for the deficiencies of Williams.

Further yet, even if the references taught or suggested all claimed limitations (which Applicants submit they do not), the Examiner has not pointed to any specific motivation that would have led one skilled in the art to make any of the alleged combinations, nor has any evidence been submitted in support of such allegations. The Examiner simply makes a conclusory statement that combining the references would be ‘good’, and cites a portion of Nilssen that has nothing to do with motivating one to combine the references. This falls far short of meeting the Examiner’s burden of establishing a *prima facie* case for obviousness.

At least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claim 85. Accordingly, Applicants respectfully request that the §103(a) rejection of claim 85 be withdrawn.

3. Claims 86-87

Applicant respectfully submits that neither Williams nor Nilssen, alone or in combination, teaches or suggests limitations of claims 86-87. Williams and Nilssen fail to teach or suggest, for example, *in which the benefit comprises a guarantee that **no less than the savings will be received by the customer during a second transaction.***

The Examiner states that Williams fails to teach or suggest the above-quoted limitation. Office Action mailed November 4, 2005, pg. 7, third paragraph from bottom; inappropriately lumped with claim 85, despite differences in claim language. The Examiner then relies upon Nilssen to make up for the deficiencies of Williams.

As described in Section C.1. above, however, the Examiner is simply misinterpreting the Nilssen reference. Nowhere does Nilssen describe a second transaction, or a savings amount, much less guaranteeing the *savings amount* for a *second transaction*. Accordingly, Nilssen simply fails to make up for the deficiencies of Williams.

Further yet, even if the references taught or suggested all claimed limitations (which Applicants submit they do not), the Examiner has not pointed to any specific motivation that would have led one skilled in the art to make any of the alleged combinations, nor has any evidence been submitted in support of such allegations. The Examiner simply makes a conclusory statement that combining the references would be ‘good’, and cites a portion of Nilssen that has nothing to do with motivating one to combine the references. This falls far short of meeting the Examiner’s burden of establishing a *prima facie* case for obviousness.

At least for these reasons, the Examiner has failed to establish a *prima facie* case of obviousness for claims 86-87. Accordingly, Applicants respectfully request that the §103(a) rejections of claims 86-87 be withdrawn.

D. 35 U.S.C. §103(a) – Williams, Walker

Claims 5, 10, 34, and 39 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Walker. As this is the same ground for rejection that the Examiner has relied upon in rejecting claims 5, 10, 34, and 39 since the first Office Action of October 3, 2002, Applicants direct the Examiner’s attention to the plurality of arguments submitted in all previous Responses and Appeal Briefs, to which the Examiner has heretofore refused to address or acknowledge. Claims 5, 10, 34, and 39 are also believed to be patentable at least for depending upon patentable base claims.

E. 35 U.S.C. §103(a) – Williams, Mindrum

Claims **26-27** and **45** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Williams in view of Mindrum. As this is the same ground for rejection that the Examiner has relied upon in rejecting claims **26-27** and **45** since the second Office Action of October 21, 2003, Applicants direct the Examiner's attention to the plurality of arguments submitted in all previous Responses and Appeal Briefs, to which the Examiner has heretofore refused to address or acknowledge. Claims **26-27** and **45** are also believed to be patentable at least for depending upon patentable base claims.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,

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Date



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